IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of: Daniels et al.	:
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Application No.: 10/827,199	: Group Art Unit: 2457
	:
Filed: April 19, 2004	: Examiner: Sall, El Hadji Malick
	:
For: Universal recallable, erasable, secure and	: Confirmation No.: 2330
timed delivery email	:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

BRIEF ON APPEAL

Sir:

Further to the Notice of Appeal filed on February 18, 2009, for the subject application, a brief in support of the appeal is now submitted. Submission of a brief in support of the appeal in this case is due by April 18, 2009, which falls on a Saturday. Accordingly, this brief is being timely filed.

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REAL PARTY IN INTEREST

The real party in interest is Bigstring Corporation, assignee of the instant application.

RELATED APPEALS AND INTERFERENCES

The undersigned is not aware of any appeals or interferences that are related to this appeal, or which will affect or have a bearing on this appeal.

STATUS OF CLAIMS

Claims 1-9 were finally rejected in an Office Action mailed on November 19, 2008 ("the Final Office Action"), and are the subject of this appeal.

STATUS OF AMENDMENTS

Claim 22, which depends upon independent claim 7, was added subsequent the Final Office Action. The new claim was not entered, because it contains limitations that were not filed in the original claims and would therefore require additional search and consideration according to the Examiner. Claim 21, which was already withdrawn from consideration prior to the Final Office Action, was cancelled without prejudice subsequent to the Final Office Action. None of the claims 1-9 which are under consideration have been amended subsequent to the Final Office Action. None of the amendments submitted after the Final Office Actions were entered.

SUMMARY OF CLAIMED SUBJECT MATTER

The claimed subject matter encompasses a process for universal recallable, erasable, secure and timed delivery email. Independent claim 1 is directed to a process for secure and timed delivery of recallable and erasable email comprising:

a sender's mail user agent creating and sending an email having a body to a sender's modified mail transport agent, (*page 10, line 22 – page 11, line 1 and page 11, lines 16-20; FIG. 2, box 14*)

said sender's modified mail transport agent preprocessing said email to create a modified email that has a link to a stored image of the body from the email substituted for the body of the email, (*page 11, lines 7-15; FIG. 2, boxes 16 and 22*)

sender's modified mail transport agent sending the modified email to a recipient's mail transport agent where the modified email is stored awaiting recipient's request, (*page 12, lines 7-16; FIG. 2, boxes 24 and 26*)

recipient's mail user agent requesting and receiving said modified email from recipient's mail transport agent, executing the link contained in the modified email to request the image of the body of the email from sender's hypertext transport protocol server, (*page 12, line 20 – page 13, line 4; FIG. 2 boxes 28 and 30*)

sender's hypertext transport protocol server obtaining the image and sending the image to the recipient, and the displaying the image of the body of the email for the recipient. (*page 13, lines 10-20; FIG. 2 boxes 36, 38 and 40*)

Independent claim 8 is directed to a process for secure and timed delivery of recallable and erasable email comprising:

a sender preselecting with sender's hypertext transport protocol server the sender's preferences for the number of times his emails will be displayable and for the length of time his emails will remain active and available for viewing, (*page 11, line 20-page 12, line 6; page 14, lines 5-22; FIG. 3, boxes 5 and 54*)

a sender's mail user agent creating and sending an email to a sender's modified mail transport agent, (*page 10, line 22 –page 11, line 1 and page 11, lines 16-20; FIG. 2, box 14*)

said sender's modified mail transport agent preprocessing said email by taking the body from the email and creating and storing an image of the body on a file system and then creating a link to the image that is inserted back into the email as a replacement for the body of the email to form a modified email, (*page 11, lines 7-15; FIG. 2, boxes 16, 18 and 22*)

sender's modified mail transport agent creates an entry for the email in a database containing the body of the email and time saved along with the sender's preselected preferences and a blank field for recording the time the email is first displayed, (*page 11, line 16-page 12, line 6; FIG. 2, box 20*)

sender's modified mail transport agent sending the modified email to a recipient's mail transport agent where the modified email is stored awaiting recipient's request, (*page 12, lines 7-16; FIG. 2, boxes 24 and 26*)

recipient's mail user agent requesting and receiving said modified email from recipient's mail transport agent, recipient executing the link contained in the modified email to request the image of the body of the email from sender's hypertext transport protocol server, (*page 12, line 20 – page 13, line 4; FIG. 2 boxes 28 and 30*)

the database recording the time the email is first displayed and counting down on the counter for the total number of times the email is displayable, (*page 13, lines 7-10, FIG. 2, box 34*)

sender's hypertext transport protocol server obtaining the image and sending the image to the recipient, and the image displayed for the recipient. (*page 13, lines 10-20; FIG. 2 boxes 36, 38 and 40*)

The dependent claims are directed to various embodiments of the disclosed process for secure and timed delivery of recallable and erasable email.

A copy of the appealed claims is appended hereto, beginning at page 23.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

I.   Whether claims 1-9 are unpatentable under 35 U.S.C. § 103(a) over Thorne et al.

(U.S. 5,958,005; "Thorne") in view of Higley (U.S. 6,065,048; "Higley").

ARGUMENT

Claims 1-9 stand finally rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Thorne in view of Higley. The claimed subject matter encompasses a process for universal recallable, erasable, secure and timed delivery email. The instant claims are directed to a process for universal recallable, erasable, secure and timed delivery email. The methods and systems of the present invention process an e-mail, which may be a standard e-mail generated by an e-mail program, by a sender's modified mail transport agent (MTA). The modified MTA makes an image of the body of the original e-mail, stores the image as a file on a server, provides the image with a link, strips the body of the e-mail from the e-mail and inserts the link to replace the body, and sends the modified e-mail now having a link as a body to the mail transport agent of the recipient. Instead of a standard e-mail of which the body or content can be copied, stored or forwarded, the recipient only has a link. Activating the link will retrieve the image file and have the image displayed. The sender may elect to for instance delete the image file. In that case, activating the link by a recipient will no longer retrieve and/or display the image.

I.   The Rejection Of Claim 1 Should Be Reversed

Thus, a pertinent element of claim 1 recites "[s]ender's modified mail transport agent preprocessing said email to create a "modified email. Claim 1 also requires that the modified email have a "link to a stored image of the body from the email substituted for the body of the email." Claim 1 further requires "sending the modified email to a recipient's mail transport agent." Claim 1 further requires the recipients mail transport

agent "executing the link contained in the modified email to request the image of the body of the email from the sender's hypertext transport protocol server."

It is respectfully noted that neither Thorner nor Higley teach or suggest any of these claim limitations, as pointed out more particularly below.

A.   Claim 1 Requires The Creation Of A Modified Email That Is Not Taught Or Suggested By Either Thorne Or Higley

As noted above, Claim 1 unambiguously requires the creation of a "modified email." The meaning of the term modified is clear. The original email must be changed to arrive at the modified email. Neither Thorne nor Higley teach or suggest the creation of a modified email as required by claim 1.

Thorne discloses that copies of the email exists in different locations:

> In this typical scenario a copy of the message now exists on a disk at each of the five different agents. These include 25 (1) the hard drive of the composing employee, (2) a first position of a post office disk of the server (sender mail box), (3) a second position of a disk serving as the exchange agent of the server, (4) a third position in the post office disk of the server (recipient mail box), and (5) the hard drive of the 30 recipient or addressee computer. If the message goes to another department it will pass through at least one additional server, and there will be even further instances of storage of the message.

See Thorne at col. 3, lines 34 to 35.

Thorne therefore teaches the creations of *copies* of the email. A *copy* of the email is the same as the original email and is not a *modified* email as required by claim 1. Thorne, therefore, fails to teach or suggest the creation of a modified email as required by claim 1. Higley is completely silent on this issue. For at least this reason, neither Thorne, Higley nor their combination teach or suggest claim 1.

B.   Claim 1 Requires The Modified Email To Include A *Link* To A Stored Image Of The Body Of The Email -- This Is Not Taught Or Suggested By Thorne Or Higley

As noted above, claim 1 unambiguously requires that a modified email have a "link to a stored image of the body from the email substituted for the body of the email." The Final Office Action and the Advisory Opinion incorrectly asserts that Thorne discloses such a link.

First, it is incorrectly asserted that Thorne discloses a link at col. 2, line 51-54. *See* Advisory Action at paragraph (A) on the Continuation Sheet. Thorne, at this section, states:

> Thus there is an existing need to provide to an E-Mail originator or sender the capability to control the ability of the recipient to copy, forward, print, and store the document.

See, Thorne, col. 2, lines 51-54. In this statement, Thorne merely states a general need or control without specifying any specific means or steps of accomplishing the general need. This section of Thorne does not teach or suggest the limitations of claim 1 including the creation of a modified email which contains "a link to a stored image of the body from the email substituted for the body of the email."

Second, it is incorrectly asserted that Thorne discloses a link at col. 2, line 51-54. *See* Advisory Action at paragraph (A) on the Continuation Sheet. Thorne, at this section, states:

> Referring to FIG. 5 the E-Mail message retrieval procedure is now described. The procedure starts at 510. At 512 the E-Mail files are opened and typically a graphical user interface is displayed. At 514 the application automatically scans all E-Mail messages to locate any secure messages

> which are subject to a ripe purge demand but somehow
> remain in the client computer. Such messages which are
> located are thereupon purged and a notification of such
> purge is sent to the user as well as to the originator or
> sender of the message.

See, Thorne, col. 9, lines 43-53. In this statement, Thorne clearly does not teach or

suggest a modified email or a modified email that contains a link. Accordingly, this

section of Thorne does not teach or suggest the limitations of claim 1 including the

creation of a modified email which contains "a link to a stored image of the body from

the email substituted for the body of the email."

Third, it is further incorrectly asserted that Thorne discloses a link at col. 3, line

18-21. *See* Advisory Action at paragraph (A) on the Continuation Sheet. Thorne, at this

section, states:

> The server includes a mail exchange agent which acts as a
> store and forward node in transport of the message either to
> another work station within the same 20 department or to
> another department.

See, Thorne, col. 3, lines 18-21. Once again, in this statement, Thorne does not teach or

suggest the limitations of claim 1 including the creation of a modified email which

contains "a link to a stored image of the body from the email substituted for the body of

the email."

Accordingly, for at least these reasons, neither Thorne, Higley nor their

combination teach or suggest claim 1.

C.   Claim 1 Requires Execution Of The Link In The Modified EMail --

This Is Not Taught Or Suggested By Thorne Or Higley

As set forth above and elsewhere, Claim 1 further requires "sending the modified

email to a recipient's mail transport agent" and then "executing the link contained in the

modified email to request the image of the body of the email from the sender's hypertext transport protocol server." The Final Office Action and the Advisory Opinion incorrectly asserts that Thorne discloses the execution of a link, as specifically required by claim 1.

D.   There Is No Need Or Motivation To Combine Thorne With Higley

Appellants disclose and claim an email system that is entirely different from the system as taught by either Thorne or Higley. The link to an image being a substitute for a body of an email stored on hypertext protocol transport server is not possible in Thorne as no such server is disclosed. Thorne also has no need for such a server, as Thorne manages deletion, printing and copying permissions of email by setting fields in a header (Thorne, figure 3), and not by replacing the body of an email by a link as required in claims 1 and 8. The Examiner asserts incorrectly that a motivation to combine Thorne with Higley is to "[a]llow connecting to servers in the web and to provide sending and receiving documents in email over the internet (see abstract)." Thorne discloses in column 4, lines 40-44 that "[A]lthough shown as a single LAN configuration, the invention is equally applicable to other communications networks including the PSTN, Internet, cellular and paging networks, individually and in combination." Accordingly, Thorne already teaches that its emails can be transmitted over the Internet and there is no need or motivation to look at Higley or elsewhere for that aspect. Accordingly, the motivation as provided by the Examiner is not sufficient.

It is respectfully suggested that the Examiner has failed to establish *prima facie* obviousness, as not all the claim limitations are taught or suggested by the prior art.

E.   The Rejection Of Claim 1 Is Improper

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966), *viz.*, (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. "[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). To establish a *prima facie* case of obviousness, all the claim limitations must be taught or suggested by the prior art. *See In re Royka*, 490 F.2d 981, 985 (CCPA 1974).

In the present case, the Examiner does not meet his burden of proof to establish that all of the claim limitations are taught or suggested by the prior art. As set forth above, neither Thorne nor Higley teach or suggest modified emails, modified mails having a link to a stored image of the body of the email or the execution of the link by a recipient of the email. Accordingly, neither Thorne, Higley nor the combination thereof teaches or suggests claim 1, and reversal of the rejection of claim 1 is respectfully requested for these reasons.

Furthermore, the combination of Thorne with Higley is inoperable to arrive at the aspects of the invention as claimed. Thorne manages security of printing, copying, forwarding, storing and the like of e-mails via special applications using message headers that can be interpreted by software. Higley provides a link to an attachment to an e-mail. Neither Thorne, nor Higley modifies a body of an e-mail to be replaced by a link of an

image of the body of the e-mail, as required by claim 1. Accordingly, it is respectfully requested that the rejection of claim 1 be reversed for these reasons.

II.   The Rejection Of Claims 2-7 Should Be Reversed

Claims 2 to 7 depend directly or indirectly from claim 1, incorporating each limitation of claim 1. Since neither Thorne, Higley nor the combination thereof teach or suggest the limitations of claim 1, they also fail to teach or suggest the limitations of claims 2 to 7. Allowance of these claims is also therefore respectfully requested for this reason.

Further as to claim 3, it is required that the email sender's modified mail transport agent strip the body from the email and create an image file of the body which is stored. It also requires that the sender's modified mail transport agent creates an entry for the email in a database. It further requires that the sender's modified mail transport agent substitutes the link in the email for the body of the email thereby creating the modified email. None of these steps are taught or suggested by Thorne, Higley or the combination thereof. Accordingly, reversal of the rejection of claim 3 is also requested for this reason.

Further as to claim 4, it is required that the entry created in the database by the sender's modified mail transport agent for the email further comprises the body of the email, a time the email was saved, a time the email is first displayed, a total number of times the email is displayable, and a removal time. None of these steps are taught or suggested by Thorne, Higley or the combination thereof. Accordingly, reversal of the rejection of claim 4 is also requested for this reason.

Further as to claim 5, it is required that certain steps be executed after the link is executed. These steps include the database recording the time the email is first displayed

and counting down one numeral on a counter for the total number of times the email image is displayable. None of these steps are taught or suggested by Thorne, Higley or the combination thereof. Accordingly, reversal of the rejection of claim 5 is also requested for this reason.

Further as to claim 6, it is required that a sender log onto a website for sender's hypertext transport protocol server, the sender viewing all active emails that he has sent and the status of each, the sender editing his active emails and editing his preferences, the sender's hypertext transport protocol server overwriting the original image files and original content of the email and changing sender's preferences. None of these steps are taught or suggested by Thorne, Higley or the combination thereof. Accordingly, reversal of the rejection of claim 6 is also requested for this reason.

Further as to claim 7, it is required that the following steps that can be performed at any time: sender logging onto a website for sender's hypertext transport protocol server, sender viewing all active emails that he has sent and the status of each, sender editing his active emails, the sender's hypertext transport protocol server overwriting the original image files and original content of the email, and sender logging off of the website. None of these steps are taught or suggested by Thorne, Higley or the combination thereof. Accordingly, reversal of the rejection of claim 7 is also requested for this reason.

III. The Rejection Of Claim 8 Should Be Reversed

Claim 8 requires a sender's modified mail transport agent preprocessing an email by taking the body from the email and creating and storing an image of the body on a file system. It further requires creating a link to the image that is inserted back into the email as a

replacement for the body of the email to form a modified email. The sender's modified mail transport agent then creates an entry for the email in a database containing the body of the email and time saved along with the sender's preselected preferences and a blank field for recording the time the email is first displayed. Then a recipient's mail transport agent stores the modified email awaiting recipient's request. Upon request, the recipient's mail user agent receives the modified email from recipient's mail transport agent, executes the link contained in the modified email to request the image of the body of the email from sender's hypertext transport protocol server. The database records the time the email is first displayed and counting down on the counter for the total number of times the email is displayable. Thus, claim 8, like claim 1, requires the creation of a modified email, a link to the modified email and the execution of the link.

For the same reasons stated with respect to claim 1, it is respectfully submitted that neither Thorne, Higley nor the combination thereof, teaches or suggests claim 8. Accordingly, reversal of the rejection of claim 8 is respectfully requested.

IV.   The Rejection Of Claim 9 Should Be Reversed

Claim 9 depends from claim 8, incorporating each limitation of claim 8. Since neither Thorne, Higley nor the combination thereof teach or suggest the limitations of claim 8, they also fail to teach or suggest the limitations of claim 9. Reversal of the rejection of claim 9 is also therefore respectfully requested for this reason.

CONCLUSION

For the foregoing reasons, Appellants maintain that claims 1-9 meet the requirements for patentability under 35 U.S.C. *et. seq.* Accordingly, reversal of the

Examiner's rejections is appropriate and is respectfully solicited.

                                    Respectfully Submitted,

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April 21, 2009

CLAIMS APPENDIX

1. A process for secure and timed delivery of recallable and erasable email comprising: a sender's mail user agent creating and sending an email having a body to a sender's modified mail transport agent, said sender's modified mail transport agent preprocessing said email to create a modified email that has a link to a stored image of the body from the email substituted for the body of the email, sender's modified mail transport agent sending the modified email to a recipient's mail transport agent where the modified email is stored awaiting recipient's request, recipient's mail user agent requesting and receiving said modified email from recipient's mail transport agent, executing the link contained in the modified email to request the image of the body of the email from sender's hypertext transport protocol server, sender's hypertext transport protocol server obtaining the image and sending the image to the recipient, and the displaying the image of the body of the email for the recipient.

2. A process for secure and timed delivery of recallable and erasable email according to claim 1 wherein sender's mail user agent employs a secure transmission in sending the email to the sender's modified mail transport agent, and sender's hypertext transport protocol server employs a secure transmission in sending the image to the recipient.

3. A process for secure and timed delivery of recallable and erasable email according to claim 1 the step of said sender's modified mail transport agent preprocessing

said email to create a modified email that has had a link to a stored image of the body from the email substituted for the body of the email further comprises: sender's modified mail transport agent strips the body from the email and creates an image file of the body and stores the image file on a file system, sender's modified mail transport agent creates an entry for the email in a database, and sender's modified mail transport agent creates a link to the stored image and substitutes the link in the email for the body of the email thereby creating a modified email.

4. A process for secure and timed delivery of recallable and erasable email according to claim 3 wherein the entry created in the database by the sender's modified mail transport agent for the email further comprises: the body of the email, a time the email was saved, a time the email is first displayed, a total number of times the email is displayable, and a removal time.

5. A process for secure and timed delivery of recallable and erasable email according to claim 4 further comprising the following steps which occur after the step of executing the link contained in the modified email to request the image of the body of the email from sender's hypertext transport protocol server: sender's hypertext transport protocol server receiving the request for the image from the recipient, and the database recording the time the email is first displayed and counts down one numeral on the counter for the total number of times the email image is displayable.

6. A process for secure and timed delivery of recallable and erasable email according to claim 5 further comprising the following steps which can occur at any time: sender logging onto the website for sender's hypertext transport protocol server, sender viewing all active emails that he has sent and the status of each, sender editing his active emails and editing his preferences, the sender's hypertext transport protocol server overwriting the original image files and original content of the email and changing sender's preferences, and sender logging off of the website.

7. A process for secure and timed delivery of recallable and erasable email according to claim 1 further comprising the following steps that can be performed at any time: sender logging onto a website for sender's hypertext transport protocol server, sender viewing all active emails that he has sent and the status of each, sender editing his active emails, the sender's hypertext transport protocol server overwriting the original image files and original content of the email, and sender logging off of the website.

8. A process for secure and timed delivery of recallable and erasable email comprising: a sender preselecting with sender's hypertext transport protocol server the sender's preferences for the number of times his emails will be displayable and for the length of time his emails will remain active and available for viewing, a sender's mail user agent creating and sending an email to a sender's modified mail transport agent, said sender's modified mail transport agent preprocessing said email by taking the body from the email and creating and storing an image of the body on a file system and then creating a link to the image that is inserted back into the email as a replacement for the body of

the email to form a modified email, sender's modified mail transport agent creates an entry for the email in a database containing the body of the email and time saved along with the sender's preselected preferences and a blank field for recording the time the email is first displayed, sender's modified mail transport agent sending the modified email to a recipient's mail transport agent where the modified email is stored awaiting recipient's request, recipient's mail user agent requesting and receiving said modified email from recipient's mail transport agent, recipient executing the link contained in the modified email to request the image of the body of the email from sender's hypertext transport protocol server, the database recording the time the email is first displayed and counting down on the counter for the total number of times the email is displayable, sender's hypertext transport protocol server obtaining the image and sending the image to the recipient, and the image displayed for the recipient.

9. A process for secure and timed delivery of recallable and erasable email according to claim 8 further comprising the following steps that can be performed at any time: sender logging onto a website for sender's hypertext transport protocol server, sender viewing all active emails that he has sent and the status of each, sender editing his active emails, the sender's hypertext transport protocol server overwriting the original image files and original content of the email, and sender logging off of the website.

EVIDENCE APPENDIX

None.

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RELATED PROCEEDINGS APPENDIX

None.